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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/998,234	12/03/2001	Jonathan L. Rowlands	TI-29978	5084
23494	7590	03/29/2006	EXAMINER	
TEXAS INSTRUMENTS INCORPORATED P O BOX 655474, M/S 3999 DALLAS, TX 75265				HENNING, MATTHEW T
ART UNIT		PAPER NUMBER		
2131				

DATE MAILED: 03/29/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	09/998,234	ROWLANDS, JONATHAN L.
	Examiner Matthew T. Henning	Art Unit 2131

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 19 October 2005.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1,3,4,7 and 13 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1,3,4,7 and 13 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 24 June 2005 is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) All
  - b) Some \*
  - c) None of:
    1. Certified copies of the priority documents have been received.
    2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) Notice of Informal Patent Application (PTO-152)
- 6) Other: \_\_\_\_\_.

1           This action is in response to the communication filed on 10/19/2005.

2           **DETAILED ACTION**

3           *Response to Arguments*

4         Applicant's argue primarily that Saito did not disclose the limitations of the second  
5         connection having a lower bandwidth than the first connection. Applicant relies on the fact that  
6         Saito did not mention the bandwidths of the connections. However, the specification of the  
7         present application is somewhat vague as to these limitations as well. The only support for these  
8         limitations comes from the first two paragraphs of the description of the preferred embodiments  
9         wherein the applicant provides an example of a "high-bandwidth data connection" as a direct  
10        connection between two devices and provides an example of a "low-speed" (the examiner is  
11        interpreting this to be interchangeable with "low-bandwidth") networks as "traditional wired or  
12        cellular telephone networks". Col. 12 paragraph 2 of Saito shows that the "first connection"  
13        between the primary and secondary user terminals can be a direct connection as opposed to a  
14        connection through the network. Based on the specification of the present application, this  
15        appears to meet the limitation of a "high-bandwidth" connection. Col. 12 Lines 1-2 of Saito  
16        show that the second connection was through a network such as a public telephone line, which,  
17        as discussed above, according to the specification of the present application is a "low-speed"  
18        connection. Therefore, although Saito does not directly address the bandwidths of the  
19        connections, based on the specification of the present application and the types of connections  
20        disclosed by Saito, Saito did disclose the required limitations. Therefore, the examiner does not  
21        find the argument persuasive and has maintained the prior art rejections presented in the office  
22        action dated 9/20/2005.

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1        All objections and rejections not set forth below have been withdrawn.

2                          ***Claim Rejections - 35 USC § 102***

3        The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the  
4 basis for the rejections under this section made in this Office action:

5        *A person shall be entitled to a patent unless –*

6                          *(e) the invention was described in (1) an application for patent, published under section  
7 122(b), by another filed in the United States before the invention by the applicant for patent or  
8 (2) a patent granted on an application for patent by another filed in the United States before the  
9 invention by the applicant for patent, except that an international application filed under the  
10 treaty defined in section 351(a) shall have the effects for purposes of this subsection of an  
11 application filed in the United States only if the international application designated the United  
12 States and was published under Article 21(2) of such treaty in the English language.*

13

14        Claims 1, and 7 are rejected under 35 U.S.C. 102(e) as being anticipated by Saito (US  
15 Patent Number 6,449,717).

16        Regarding claim 1, Saito disclosed a method of data distribution preserving rights of a  
17 remote party (See Saito Abstract and Fig. 1) comprising the steps of: an authorized user locally  
18 transmitting data to a receiver (See Saito Fig. 1 and Col. 6 Lines 34-36) employing a local  
19 connection having a first bandwidth (See Saito Col. 12 Second Paragraph); and following said  
20 locally transmitting step, authorizing the receiver's use of the data by a trusted agent (See Saito  
21 Col. 6 Lines 48-65) employing a network having a second bandwidth less than said first  
22 bandwidth (See Saito Col. 12 Lines 1-2).

23        Regarding claim 7, Saito disclosed that said step of locally transmitting data includes  
24 directly connecting an apparatus of the authorized user to an apparatus of the receiver (See Saito  
25 Col. 12 Lines 9-10).

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**1                   Claim Rejections - 35 USC § 103**

2                 The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all  
3                 obviousness rejections set forth in this Office action:

4                 *A patent may not be obtained though the invention is not identically disclosed or*  
5                 *described as set forth in section 102 of this title, if the differences between the subject matter*  
6                 *sought to be patented and the prior art are such that the subject matter as a whole would have*  
7                 *been obvious at the time the invention was made to a person having ordinary skill in the art to*  
8                 *which said subject matter pertains. Patentability shall not be negated by the manner in which*  
9                 *the invention was made.*

10

11                 Claims 3-4, and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over  
12                 Downs et al. (US Patent Number 6,574,609) hereinafter referred to as Downs, and further in  
13                 view of Saito.

14                 Regarding claim 3, Downs disclosed a method of data distribution preserving rights of a  
15                 remote party comprising the steps of: the sender choosing an encryption key for the receiver's  
16                 use (See Downs Col. 22 Lines 17-19); the sender encrypting the data using the key (See Downs  
17                 Col. 22 Lines 17-19); the sender encrypting the encryption key using a public encryption key of  
18                 a trusted agent (See Downs Col. 22 Lines 20-21); the sender locally transmitting both the  
19                 encrypted data and the encrypted key to the receiver (See Downs Col. 22 Lines 30-59 and Col.  
20                 23 Lines 36-41); the receiver and the trusted agent negotiating licensing and payment for the data  
21                 (See Downs Col. 22 Line 60 – Col. 23 Line 28); the receiver transmitting the encrypted key to  
22                 the trusted agent (See Downs Col. 22 Line 60 – Col. 23 Line 28); the trusted agent decrypting the  
23                 encryption key (See Downs Col. 23 Lines 22-23); and the trusted agent sending the decrypted  
24                 encryption key to the receiver to receive the full data (See Downs Col. 23 Lines 22-28), but

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- 1      Downs failed to disclose that the encrypted data could be transmitted prior to the license
- 2      negotiation and key transmission.

3               Saito teaches a content distribution system in which a first user provided a second user  
4      with encrypted content employing a local connection (See Saito Col. 12 Paragraph 2), followed  
5      by the second user negotiating use of the content and receiving the decryption key from a trusted  
6      agent (See Saito Fig. 1 and related text) employing a local telephone line (See Saito Col. 12  
7      Lines 1-2).

8               It would have been obvious to the ordinary person skilled in the art at the time of  
9      invention to employ the teachings of Saito in the content distribution system of Downs by  
10     transferring content directly from a first user to a second user followed by the second user  
11     negotiating license and usage of the content and acquiring the decryption key for the content.  
12     This would have been obvious because the ordinary person skilled in the art would have been  
13     motivated to provide more flexible distribution of the content while protecting the interests of the  
14     copyright owner of content.

15               Regarding claim 4, the combination of Downs and Saito disclosed the receiver choosing a  
16     new encryption key unknown to the sender and encrypting the data with the new encryption key  
17     (See Downs Col. 79 Lines 26-37).

18               Regarding claim 13, the combination of Downs and Saito disclosed that said step of  
19     locally transmitting both the encrypted data and the encrypted key includes directly connecting  
20     an apparatus of the sender to an apparatus of the receiver (See Saito Col. 12 Lines 9-10).

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### ***Conclusion***

Claims 1, 3-4, 7, and 13 have been rejected.

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time

policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE

6 MONTHS from the mailing date of this action. In the event a first reply is filed within TWO

7 MONTHS of the mailing date of this final action and the advisory action is not mailed until after

8 the end of the THREE-MONTH shortened statutory period, then the shortened statutory period

9 will expire on the date the advisory action is mailed, and any extension fee pursuant to 37

10 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing

12 date of this final action.

Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Matthew T. Henning whose telephone number is (571) 272-3790.

The examiner can normally be reached on M-F 8-4.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Ayaz Sheikh can be reached on (571) 272-3795. The fax phone number for the

18 organization where this application or proceeding is assigned is 571-273-8300.

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1       Information regarding the status of an application may be obtained from the Patent  
2       Application Information Retrieval (PAIR) system. Status information for published applications  
3       may be obtained from either Private PAIR or Public PAIR. Status information for unpublished  
4       applications is available through Private PAIR only. For more information about the PAIR  
5       system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR  
6       system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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9



10     Matthew Henning  
11     Assistant Examiner  
12     Art Unit 2131  
13     3/22/2006

CHRISTOPHER REVAK  
PRIMARY EXAMINER

 3/26/06